REMARKS

This request for consideration is being submitted at that request of **Supervisory Examiner Tuan Dam**. Please handle this in an **URGENT** manner. The six month date from the Final Action is **July 3, 2007**.

Both the Final Office Action and the Advisory Action were erroneously issued based on the incorrect belief that the Applicant had not previously shown how the present claims were supported in the applications to which this application claims priority.

However, the mapping between the portions of *iFS-Dguide 1.1* and *iFS-Dguide 1.0* (which was contained in the provisional) that are the used in the current rejections is shown in the painstakingly-prepared table contained in one of Applicant's previous responses.

By incorporating the provisional, *iFS-Dguide 1.0* was included in the parent application to which priority is sought. Therefore, the parent application contains substantially the same content as those portions of *iFS-Dguide 1.1* that are being used as the basis of the current rejection.

In light of the foregoing, the present application is entitled to the priority claim of provisional application 60/204,196, which is the "grandparent" of the present application. Because the priority claim is proper, the rejections are not.

APPLICANT'S PRIOR RESPONSES ARE REPRODUCED HEREAFTER

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1-45 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by "Oracle® Internet File System Developer's Guide", Release 1.1, published in September 2000 ("*iFS-Dguide 1.1*"); and

Claims 1 and 24 were again rejected under 35 U.S.C. §102(b) as allegedly anticipated by *iFS-Dguide 1.1*.

PRIORITY DATE

Applicants first thank the examiner for drawing attention to the fact that the application is currently erroneously categorized as a "continuation" rather than a "continuation-in-part" of U.S. Pat. Appl. No. 09/853,823, which claims priority to U.S. Provisional Appl. No. 60/204,196, filed May 12, 2000 (*see*, e.g., Filing Receipt mailed 02/05/2002 and Updated Filing Receipt mailed 05/07/2002). In response, the specification is amended herein to correct the reference to the prior non-provisional application under 37 CFR 1.78(a)(2)(i). Entry of this amendment to the specification is respectfully requested, as is corrective action to the record to accurately reflect the relationship of this application to its earlier filed non-provisional parent application (i.e., a continuation-in-part).

It is understood that, because this application is a continuation-in-part of U.S. Pat. Appl. No. 09/853,823 rather than a continuation, Applicants are only entitled to the priority date of U.S. Provisional Appl. No. 60/204,196 if there is continuity of disclosure among the applications in the claimed chain of priority. Stated otherwise, the subject matter of the present claims needs to be fully disclosed in the prior-filed applications to which this application claims priority in a manner to enable one skilled in the art to use the invention.

In support of the rejection of Claims 1-45 under 35 U.S.C. §102(b) and in support of the rejection of Claims 1 and 24 under 35 U.S.C. §102(b), the Office Action asserts that every element in the present claims is fully disclosed in the various cited sections of the *iFS-Dguide 1.1*. Hence, if that is true, then it follows in this case that every element of the present claims is also fully disclosed and enabling to one skilled in the art in the corresponding sections of

"Oracle® Internet File System Developer's Guide", Release 1.0 ("*iFS-Dguide 1.0*"), which was filed in U.S. Provisional Appl. No. 60/204,196 on May 12, 2000, the entire disclosure of which U.S. Pat. Appl. No. 09/853,823 incorporates by reference.

For example, *iFS-Dguide 1.0* recites practically the same subject matter as that relied upon from *iFS-Dguide 1.1* for the rejection of Claim 1, a mapping of which is presented in the tables that follow.

(I) Rejection of **Claims 1-45** under 35 U.S.C. §102(b) in view of *iFS-Dguide 1.1*

iFS-Dguide 1.1	***iFS-Dguide 1.0***
Sample Code: Create Document Instances page 4-14, lines 7-25	Sample Code: Create Document Instances page 4-15, lines 1-20
Sample Code: Create an Instance Class Bean pages 4-10 to 4-12	Sample Code: Create an Instance Class Bean pages 4-12 to 4-13
Creating Document Instances page 4-13, lines 9-13	Creating Document Instances page 4-14, lines 1-5
What is a Parser? page 5-2, lines 1-16	What is a Parser? page 5-2, lines 1-16
Sample Code: A Custom Parser? page 5-10 to 5-15	Sample Code: A Custom Parser? page 5-10 to 5-13
attributes (public class SimplestParser) page 5-11, lines 24-30	attributes (public class VcardParser) page 5-10, lines 31-440
How does XML Parsing Work? page 5-6	How does XML Parsing Work? page 5-5
Using a Custom Parser page 5-7, lines 7-16	Using a Custom Parser page 5-4, lines 16-32
What is a Parser? page 5-2, lines 1-16	What is a Parser? page 5-2, lines 1-16
Using the Standard Parsers page 5-3, lines 3-14	Using the Standard Parsers page 5-3, lines 1-12
Write the Parser Class page 5-9, lines 6-13	Write the Parser Class page 5-7, lines 23-30
Sample Code: A Custom Parser page 5-11, lines 6-8	Sample Code: A Custom Parser page 5-10, line 9

(II) Rejection of Claims **1 and 24** under 35 U.S.C. §102(b) in view of *iFS-Dguide 1.1*

iFS-Dguide 1.1	***iFS-Dguide 1.0***
How Documents are Stored in the Repository page 3-2, lines 1-10	How Documents are Stored in the Repository page 3-2, lines 1-10
Sample: Create a Document Definition Object page 3-6, lines 7-8; page 3-10, lines 1-17	Sample: Create a Document Definition Object page 3-6, lines 7-8; page 3-10, lines 1-17
Sample: Create a Document Definition Object page 3-6, line 6; page 3-5, lines 1-24	Sample: Create a Document Definition Object page 3-6, line 6; page 3-5, lines 1-24
The Document Definition Class page 2-12, lines 16-31	The Document Definition Class page 2-12, lines 16-31
Sample: Create a Document Definition Object page 3-6, lines 7-8	Sample: Create a Document Definition Object page 3-6, lines 7-8
Setting Attributes page 3-9, lines 1-11 and 20-28	Setting Attributes page 3-9, lines 1-11 and 20-28
How Documents are Stored in the Repository page 3-2, lines 1-10	How Documents are Stored in the Repository page 3-2, lines 1-10

Based on the foregoing tables, it is shown that the disclosure of the prior-filed provisional application, which includes *iFS-Dguide 1.0*, effectively contains the same subject matter as the cited reference *iFS-Dguide 1.1*. Based on the forgoing, it is also shown that the disclosure of the prior-filed non-provisional application complies with the first paragraph of 35 U.S.C. §112 with respect to the present claims because the prior-filed non-provisional application contains the entire disclosure of the prior-filed provisional application, which adequately supports and enables the subject matter claimed in the present application. Therefore, the present application is entitled to the earliest effective filing date of U.S. Provisional Application No. 60/204,196. Hence, the earliest effective priority date for the present application is the date of the provisional application, **May 12, 2000**, not December 28, 2001.

THE REJECTIONS BASED ON THE PRIOR ART

Claims 1-45 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by *iFS-Dguide 1.1* and Claims 1 and 24 were again rejected under 35 U.S.C. §102(b) as allegedly

anticipated by *iFS-Dguide 1.1*. These rejections are traversed based on the fact that *iFS-Dguide 1.1* does not qualify as prior art to the present application. This assertion is based on the foregoing discussion showing that the present application is entitled to the filing date of **May 12, 2000**, which is prior to the publication date of the *iFS-Dguide 1.1*, which is **September 2000**. Therefore, reconsideration and withdrawal of the rejection of Claims 1-45 and the rejection of Claims 1 and 24 under 35 U.S.C. §102(b) is respectfully requested.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1-45 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by "Oracle® Internet File System Developer's Guide", Release 1.1, published in September 2000 ("*iFS-Dguide 1.1*"); and Claims 1 and 24 were doubly rejected under 35 U.S.C. §102(b) as allegedly anticipated by *iFS-Dguide 1.1*.

No separate argument is provided herein for these prior art rejections because these rejections necessarily fail if the claim of priority is acknowledged (because the art that serves as the basis for the rejections ceases to qualify as prior art).

PRIORITY CLAIM

SUFFICIENCY OF THE DISCLOSURE OF THE INSTANT APPLICATION

The Office Action did not acknowledge the priority claim to parent application (09/853,823) as a continuation-in-part. Specifically, the Office Action indicated that the priority claim was rejected because the Applicants failed to "show how and where the disclosure of the **instant application** is sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112 to be categorized as a CIP."

Thus, the sufficiency of the disclosure of the "**instant application**" appears to be the basis for the rejection. With respect to the instant application (the application that is claiming CIP status), the content requirement is simply that application must repeat "a substantial portion or all of the earlier nonprovisional application". (see MPEP 201.8)

In response, the Applicants point out that:

(a) the instant application incorporates by reference the entire disclosure of the parent application (application number 09/853,823, which has now issued as patent number 7,185,005) and

(b) both the instant application and the parent application incorporate provisional application number 60/204,196 by reference.

Specifically, the instant application, as filed, states:

> PRIORITY CLAIM AND CROSS-REFERENCE TO RELATED APPLICATIONS
>
> This application is related to and claims domestic priority from prior U.S. Patent Application Serial Number 09/853,823, filed on May 11, 2001 entitled "Nested Transactions in a File System", by David Long and David Pitfield, which claims domestic priority from prior **U.S. Provisional Application Serial Number 60/204,196**, filed on May 12, 2000 entitled "Techniques and Features of an Internet File System", by David Long. **The entire disclosure of both of these documents is hereby incorporated by reference as if fully set forth herein.**

The parent, as filed, states:

> PRIORITY CLAIM AND CROSS-REFERENCE TO RELATED APPLICATIONS
>
> This application is related to and claims domestic priority from prior **U.S. Provisional Patent Application Serial Number 60/204,196** filed on May 12, 2000 entitled "Techniques and Features of an Internet File System", by David Long, **the entire disclosure of which is hereby incorporated by reference as if fully set forth herein**.

It is respectfully submitted that these incorporation by references fully comply with all requirements, as elaborated in MPEP 601.08(p) and 37 CFR 1.57. Due to the incorporation of the parent application into the instant application, the disclosure of the present application clearly repeats a substantial portion of the parent application.

It should be noted that the effectiveness of the incorporation by reference does not hinge in any way on the priority claim. Therefore, it cannot be said that the disclosure of the instant application is insufficient because of the rejection of the priority claim (which rejection is based on the proposition that the disclosure of the instant application is insufficient...). Such reasoning would be both legally wrong, and circular.

By identifying these incorporations by reference, it is respectfully submitted that the Applicant has identified both "how and where" the disclosure of the present application is sufficient to satisfy the requirement that the disclosure of the instant application repeat "a substantial portion or all of the earlier nonprovisional application".

SUFFICIENCY OF THE DISCLOSURE OF THE PARENT APPLICATION

The present Office Action does not appear to question the sufficiency of the disclosure of the parent application. However, to expedite prosecution, Applicants point out that it would not make sense to question the sufficiency of the disclosure of the parent application.

Specifically, it would be logically inconsistent to say that (a) the claims are anticipated by portions of *iFS-Dguide 1.1*, and (b) those same claims are not entitled to the priority date of a provisional **that contains effectively the same content as those portions**. (Actually, the provisional contains the same content, and much more).

The mapping between those portions of *iFS-Dguide 1.1* and *iFS-Dguide 1.0* (which was contained in the provisional) is shown in the painstakingly-prepared table contained in Applicant's previous response. By incorporating the provisional, *iFS-Dguide 1.0* was included in the parent application to which priority is sought. Therefore, the parent application contains substantially the same content as those portions of *iFS-Dguide 1.1* that are being used as the basis of the current rejection.

In a nutshell, either those portions describe the claimed invention (in which case the priority claim is good and the prior art rejection is bad), or those portions do not describe the claimed invention (in which case the priority claim may be bad and the prior art rejection is also bad). Applicant does not understand how the Office Action can sustain a position in which the priority claim is bad, yet the prior art rejections are good.

SUFFICIENCY OF THE DISCLOSURE UNDER 112

The Office Action requests for the applicant to "show how and where the disclosure of the **instant application** is sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112 to be categorized as a CIP". This request mentions both the CIP priority claim and the requirements of 35 U.S.C. 112. However, whether the instant application has disclosure sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112 is really separate from the question of whether the instant application can be characterized as a CIP.

If the disclosure of the instant application did not satisfy the requirements of 35 U.S.C. 112, then the appropriate rejection would be that one or more claims were invalid for failure to satisfy the "enablement" or "written description" requirement. Since the Office Action did not reject any claims based on enablement or written description, then it must be assumed that the reference to 35 USC 112 was in error.

If the reference to 35 USC 112 was not an error, and the Examiner believes that the disclosure of the instant application gives rise to a 35 USC 112 rejection, then the Examiner is invited to issue a non-final action that specifies exactly why the Examiner believes that the disclosure of the instant application fails to satisfy 35 USC 112 (i.e. which claimed elements are not described or enabled by the specification).

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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